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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,405	07/05/2001	Nicolas Albisetti	20892-22	3280

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EXAMINER

BUECHNER, PATRICK M

ART UNIT	PAPER NUMBER
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3754

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/899,405

Applicant(s)

ALBISETTI, NICOLAS

Examiner

Patrick M Buechner

Art Unit

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10, 12-16, 22 and 24-90 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25 and 26 is/are allowed.
- 6) ☒ Claim(s) 1-7, 14, 22, 24, 27-34, 41, 49, 50, 79-84 and 88 is/are rejected.
- 7) ☒ Claim(s) 36 and 55 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                                                             |                                                                                         |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11, 14</u> . | 6) <input type="checkbox"/> Other: _____                                                |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 10,12,13,15,16, 35, 37-40, 42-48, 51-54, 56-78, 85-87, 89 and 90.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Species VII in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. In applicant's election, paper No. 9, applicant states claims 1-7, 13-15, 22, 24-34, 36, 40-42, 49-50, 55, 69-84 and 87-89. Examiner believes the reference to claims 69-84 is a typo that should read 79-84. Additionally, claims 13, 40 and 87 do not read on Species VII, since there is no break off portion shown in Species VII. Also, claims 15, 42 and 89 do not read on Species VII, since the outlet channel does not open to the outside in Species VII. The listing of claims that have been examined are as follows: 1-7, 14, 22, 24-34, 36, 41, 49, 50, 55, 79-84 and 88.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "140" has been used to designate both a dispensing end piece (Figure 11) and a device (Figure 13). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
4. Applicant states in paper No. 7 that a separate letter to the draftsman was sent to address the deficiency in 3 above. No such letter is in the file of the application.

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*Specification*

5. The amendment filed 7/7/2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the incorporation by reference of US application No. 09/905,044.

Applicant is required to cancel the new matter in the reply to this Office Action.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-7 and 29-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Gregoire (US 5,860,569).

Gregoire discloses a receptacle (10) having an axis (X-X), a compressible bellows portion (46), first (unlabelled at/near 36) and second (unlabelled at/near 24/72) bearing surfaces, the first bearing surface at or near the dispensing endpiece (48). The device of Gregoire is capable of performing the functional language of enabling a user to exert pressure along the axis to move the bearing surfaces and compress the bellows. The device of Gregoire is also capable of performing the functional language of the user using the device with one hand and bringing the one hand in contact with the surface the substance is to be applied.

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Gregoire also discloses the second bearing surface defined by a transverse wall (unlabelled between 24 and 72). Gregoire also discloses the second bearing surface formed around a constricted portion (24) of the receptacle in which the middle and index fingers *can* be placed during use.

Gregoire also discloses a removable plug (28) that is removed by a rod (29) attached to the dispensing endpiece, the removable plug forming two compartments in the container (20, 22) each compartment holding a different substance (column 2, lines 50-55).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 14, 28 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregoire in view of Savary (US 2,757,824).

Gregoire discloses all the limitations of claims 14, 28 and 41, as discussed above in 7, with the exception of the outlet being off center from the container.

Savary teaches an outlet off center from the container (Figures 1-3 and 5).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the container of Gregoire with an off center outlet as taught by Savary.

Doing so would be an obvious relocation of an existing part, as Savary discloses the locations are equivalent (Figures 1-5).

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13. Claim 22, 49, 50 and 79-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregoire in view of Yamamoto et al. (US 6,332,726).

Gregoire discloses all the limitations of claims 22, 49, 50 and 79-84, as discussed above in 7, with the exception of multiple outlets.

Yamamoto teaches multiple outlets.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the device of Gregoire with multiple outlets as taught by Yamamoto.

Doing so would be an obvious duplication of parts that would allow for more product to be dispensed at the same time over a greater area.

14. Claim 88 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gregoire in view of Yamamoto as applied to claim 79 above, and further in view of Savary.

Gregoire in view of Yamamoto discloses all the limitations of claim 88, with the exception of the outlet being off-center.

Savary teaches an outlet off center from the container (Figures 1-3 and 5).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the container of Gregoire/Yamamoto with an off center outlet as taught by Savary.

Doing so would be an obvious relocation of an existing part, as Savary discloses the locations are equivalent (Figures 1-5).

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### *Double Patenting*

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 1, 2, 24 and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3 and 40 of copending Application No. 09/905,044. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed structure is encompassed in claims 1, 3 and 40 and the methods claimed are inherent in the use of the device in claims 1, 3 and 40.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Allowable Subject Matter*

15. Claims 36 and 55 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. Claims 25 and 26 are allowed.



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17. The indicated allowability of claim 4 is withdrawn in view of a reinterpretation of Gregoire as discussed above in 7.

### ***Response to Arguments***

18. Applicant's arguments filed 3/11/2003 have been fully considered but they are not persuasive. Applicant argues that there is no disclosure that the device of Gregoire can be manipulated by hand, however, there are numerous disclosures in Gregoire of manual operation by hand (column 3, lines 43-46, column 4, lines 33-47). Therefore it is apparent to one having ordinary skill in the art that the device of Gregoire is capable of performing the functional language limitations claimed by applicant. Applicant argues that the end portion of Savary cannot be added to the dispenser end portion of Gregoire. This argument is spurious, as nothing from Savary is being added to Gregoire, Savary is just used to teach that an outlet can be located in the center or offset, and since Gregoire already has an outlet, nothing from Savary is being added.

### ***Conclusion***

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick M Buechner whose telephone number is (703) 308-2602. The examiner can normally be reached on 7:00am-4:30pm M-Th and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene can be reached on (703) 308-2696. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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KENNETH BOMBERG  
PRIMARY EXAMINER